

REMARKS

Claims 1 - 22 are currently pending in the application. No amendments have been made to the claims as originally filed (claim1-20). New claims 21 and 22 have been added which are directed to the printer which is operable with the information server and user terminal as is specified in original claim 1. A check for \$400 is attached to satisfy the fee for two additional independent claims. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each.

It is noted with appreciation that the Examiner has acknowledged receipt of the foreign priority under 35 U.S.C. 119(a) - (d). It is further noted that the Examiner has acknowledged that the IDS, submitted on 4/19/2001 is in compliance with 37 C.F.R. 1.97 and is being considered with the application.

Claims 1 - 3, 8 - 10, 13, 14 and 18 have been rejected under 35 U.S.C. 102(e) as being anticipated by Gacek (6,795,205). This rejection is traversed.

With respect to claim 1, the subject invention specifies a printer capable of computing an amount of information printed and providing a notification of that amount of information. As recited in claim 1,

"...wherein said printer comprises....

means for **notifying an amount** of information acquired from said information providing server and printed;...."

This is different from Gacek in which only the servers can calculate the amount of information printed by the printers. The Examiner has cited column 13, lines 9 - 11 as providing the same feature as the subject invention. This is incorrect. Gacek, as cited by the Examiner, states, "Preferably, CPSI server 312 sends a confirmation to third-party merchant 302 that the print job was transmitted to STB 322 of home user 320."

The Examiner then cites column 13, lines 11 - 16 as providing the same feature of claim 1. This is incorrect. Claim 1 states,

“...wherein said information providing server comprises:

means for calculating a total of the amount of information notified by said printer.”

The reference cited by the Examiner in Gacek, column 13, lines 11 - 16 states, “The payment which was tendered by third-party merchant 302 to intermediary service 305 during negotiations is then resolved with home user 320, thereby compensating home user 320 for the printer-related consumables, such as ink and paper, which are utilized by printer 324 during printing of the print job.” This reference does not address the feature of the claim. The claim is clearly stating that the printer notifies the information system of the amount of information printed at any one time. The information providing server then calculates the total information printed as notified by the printer.

Gacek does not provide this feature, therefore, the subject invention is not anticipated by Gacek. New claims 21 and 22 are not anticipated for the same reasons discussed above.

With respect to claim 2, this is a dependent claim whose base claim describes a printer that has at least two features not provided by Gacek as discussed above. As a dependent claim, the printer of claim 2 includes all the features of the base claim.

With respect to claim 3, the Examiner states that the subject invention feature of printing the information only if it has been updated from the last information printed is the same as that discussed in Gacek. This is also not correct. The reference cited by the Examiner of Gacek (S409 - S410, columns 14 - 15, lines 58 - 67, 1 - 20) does not mention updating nor its referring to updating. The reference cited below mentions a token which is a type of authentication to print provided by Gacek. This is not related to updating and there is no mention of the requirement for updating anywhere within Gacek and specifically not in the reference cited by the Examiner.

Referring to claim 8, the connection to the internet is relative to the printer of claim 1. As a dependent claim, the printer of claim 2 includes all the features of the base claim. These features are not provided by Gacek, thus the connection of the subject invention printer to the Internet is not provided by Gacek.

With respect to claim 9, this claim has the similar limitation to that which is discussed for claim 1 above. Specifically, the subject invention specifies a printer capable of computing an amount of information printed and providing a notification of that amount of information. As recited in claim 9,

“...notifying an amount of the printed information to said information providing server;....”

The servers in Gacek provide the print notification and not the printer as specified by the subject invention.

As for claim 10, the same argument applies as discussed above for claim 8. That is, the connection to the internet is relative to the printer of claim 9. As a dependent claim, the printer of claim 10 includes all the features of the base claim. These features are not provided by Gacek, thus the connection of the subject invention printer to the Internet is not provided by Gacek.

With respect to claims 13 and 18, these claims also have the similar argument as for claims 1 and 9 discussed above. Specifically, these claims include the feature of a printer which notifies the server of the information printed. These claims do not specify the feature in which the server provides the notification of printed information as specified by Gacek.

Claims 1, 11, 12, 15 - 17, 19 and 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (6,615,183 B1). This rejection is traversed.

Claims 1, 11, 12, 15 - 17, 19 and 20, as well as new claims 21 and 22, all contain directly or by dependency, the feature discussed above. That is, the printer has the ability to notify the information providing system of the information printed. This is not a feature provided by Kolls. The reference cited by the Examiner (block 1502,

column 36, lines 55 - 60) does not identify the feature of the subject invention. This reference relates to what type of data can be included as transaction data to be printed. This is not the feature identified in the independent claims 1, 11, 15, 19, 21, and 22.

Furthermore, the Examiner has rejected several of the dependent claims based on the use of the Internet as the connection means. The similar argument discussed above relative to Gacek also applies here. That is, the connection to the internet is relative to the printer of the specified in the independent claims. As a dependent claim, The printer of claims 12 and 16 includes all the features of the base claims. These features are not provided by Kolls, thus the connection of the subject invention printer to the Internet is not provided by Kolls.

Finally, claims 17 and 20 are also dependent claims. These claims incorporate all the features of the base claims upon which they depend. As such, the printer feature of notifying the information provider service of the information that has been printed is also a feature of these dependent claims and is not provided by Kolls.

Claims 4 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls in view of Massarsky (6,718,123). This rejection is traversed.

Claim 4 of the subject invention identifies the feature of printing the information in the margin of the print medium. Again, the feature is subject to the limitations of claim 1, that is that the printer be capable of notifying the information service provider that information has been printed. As noted above, the feature is not present in Kolls. It is also not present in Massarsky. Thus, no combination of Kolls and Massarsky would make the claimed invention of claim 4 obvious.

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls in view of Massarsky (6,718,123) and Muramatsu et al. (5,818,606). This rejection is traversed.

Claim 5 of the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1. That is, the printer is capable of

notifying the information service provider that information has been printed. Muramatsu lacks this feature, and therefore does not make up for the deficiencies of Kolls and Massarsky. As such, no combination of Kolls, Massarsky and Muramatsu would make the claimed invention obvious.

Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls in view of Freedman (4,839,829). This rejection is traversed.

The arguments for claim 6 are similar to those discussed above for claims 4 and 5. That is, the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1, that the printer be capable of notifying the information service provider that information has been printed. This feature is not anticipated by Kolls. Freedman also does not have this feature. Thus, in any combination Kolls with Freedman would not make claim 6 obvious since the combined entity would also lack the feature.

Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls in view of DeBruin-Ashton (6,014,629). This rejection is traversed.

The arguments for claim 7 are similar to those discussed above for claims 4, 5 and 6. That is, the subject invention identifies the feature of printing the information in the margin of the print medium when said print field is reduced. Again, the feature is subject to the limitations of claim 1, that the printer be capable of notifying the information service provider that information has been printed. DeBruin-Ashton lacks this feature, as does Kolls. No combination would make claim 7 obvious because the combination of Kolls and DeBruin-Ashton would lack the feature.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1 - 22 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax:

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703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson, P.C.).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael E. Whitham', is written over a horizontal line.

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